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| 09/955,529 | 09/17/2001 | Mark Peting | 50588/339 | 8578 |
| 32641 DIGEO, INC C | 7590 01/24/2008 C/O STOEL RIVES LLP | EXAMINER | | |
| 201 SOUTH MAIN STREET, SUITE 1100 | | | AHN, SAM K | |
| ONE UTAH C SALT LAKE C | ENTER CITY, UT 84111 | | ART UNIT | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| Office Action Summary Examiner Sam K. Ahn S | | | • | | 49 | | |
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| ## Examiner Sam K. Ahn 2011 - The MAILING DATE of this communication appears on the cover sheet with the correspondence address — Period for Repty A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 3 CPR 1.136(a). It is not event, however, may a reply be timely fixed to reply its specified with predict all apply and ellegars 81 (b) MONTHS from the mailing date of this communication. - Failure to reply whilin the set of extended princid for righy will by statistic, cause the application become ABANDONED (38 I S. C. § 133). - More than 19 the Office is set of mailtoner to right will be the mailing date of this communication. - Failure to reply whilin the set of extended princid for righy will by statistic, cause the application become ABANDONED (38 I S. C. § 133). - Failure to reply whilin the set of retailure and the mailing date of this communication. - Failure to reply whilin the set of retailure the mailing date of this communication. - Failure to reply whilin the set of retailure the mailing date of this communication. - Failure to reply whilin the set of retailure the mailing date of the communication, even if timely fixed, ring received any set of the mailing date of the communication. - Failure to reply whilin the set of retailure the mailing date of the communication. - Failure to reply whilin the set of retailure the mailing date of the communication. - Failure to reply whilin the set of retailure the mailing date of the some mailing date of this communication. - Failure to reply whilin the application is condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Exp parts Quayle, 1935 C. D. 11, 453 O.G. 213. - Disposition of Claims - Application of Claims - Application of Laims - Application is objected to by the Examiner. - Application Papers - A | | | Application No. | Applicant(s) | | | |
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U.S. Patent and Trademark Office PTOL-326 (Rev. 08-06) Application/Control Number: 09/955,529

Art Unit: 2611

DETAILED ACTION

Response to Arguments

 Applicant's arguments filed 11/12/07 have been fully considered but they are not persuasive. On page 13, applicants assert that the specification on pages 88 and 89 discloses the written requirement of recitation of claim 30 (which appears to pages 85 and 86 of the specification).

Paragraph 212 of the instant application simply notes "the apparatus and method... may be implemented... into a format or machine-readable medium for use within a software tool for designing a semiconductor IC" all mentioned in a single paragraph. All the paragraphs of the specification cited in the argument merely states that the apparatus and method may be implemented in the machine-readable medium, but the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention of how the computer-readable medium comprising set of instruction performs the steps recited in the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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2. Claims 22,24 and 25 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The original disclosure supports only a statutory/hardware system/method with only a brief mention that such hardware system/method can be or may be performed/substituted by various combinations of software and hardware without any adequate and enabling disclosure, therefore, the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention of how the computer-readable medium comprising set of instruction performs the steps recited in the claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 3. Claims 21,22,24-31,33-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
 - Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56

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U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in 101. Paragraph 211defines the machine-readable medium includes propagation medium that is a signal, thus is nonstatutory. And further, the method of claim 21 is of the method implemented by a computer performing steps for a signal, thus is nonstatutory. Claims 22,24-29,31,33-40 directly or indirectly depend on claim 21 or 30.

Allowable Subject Matter

4. Claims 1,2,4-12,15,16 and 45 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Ahn whose telephone number is (571) 272-3044. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ghayour can be reached on (571) 272-3021. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sam K. Ahn
Patent Examiner

1/17/08